

## REMARKS

Regarding the drawings, the drawings stand objected to under 37 CFR 1.83(a) for failure to show every feature of the invention specified in the claims. In particular, the office action states that the "mounting flange integral to the top edge" as set forth in claim 4, the "radar device" as set forth in claim 8, and the "storage integrally connected to the bottom surface" as set forth in claim 10 must be shown. Applicant now attaches an additional drawing depicting an alternative embodiment having each of these recited features. Applicant has further included a new paragraph in the Detailed Description explaining the added features. Applicant asserts that the additions to the drawings and the Detailed Description were made to conform the specification the claims as originally filed and do not include new matter. Accordingly, the objection to the drawings is overcome.

Regarding the claims, claims 13-16 stand objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 1 stands rejected under 35 USC 102 as being anticipated by Lipman (U.S. Pat. No. 4,981,363). Claims 2-7, 11, and 12 stand rejected under 35 USC 103(a) as being unpatentable over Lipman ('363) as applied to claim 1, and further in view of Annas (U.S. Pat. No. 3,665,392). Finally, claims 8-10 and 13-16 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 13-16 stand objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. In

particular, the office action states that Applicant is required to cancel claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Claims 13-16 are now canceled and their limitations have been incorporated in independent form as new method claims 17-20. Accordingly, the objection to claims 13-16 has been overcome.

Claim 1 stands rejected under 35 USC 102 as being anticipated by Lipman ('363). Specifically, the office action states that Lipman discloses a housing "82", a plurality of light generators "104 and 108", and supports "28" which mount the housing to the windshield of the vehicle. This rejection is respectfully traversed.

Claim 1 has been amended to include the following, "means for internally mounting said housing to said *interior roof of said vehicle*." (Emphasis supplied). As stated in the office action, Lipman includes a housing that is mounted directly to the windshield of the vehicle. As stated in the Summary of the Invention, the housing of the present invention "*attaches along one edge to the headliner or interior roof of the vehicle* with the opposing edge of the housing extending to and along the contour of the windshield glass." (Page 5, lines 1-5, emphasis supplied). The housing of the present invention is not mounted to the windshield, but merely abuts the windshield along the leading edge of its horizontal planar member. This feature is not disclosed, suggested or taught by the prior art cited in the office action. Nor is there any motivation present in the reference for mounting the housing directly to the headliner or interior roof of a vehicle. Accordingly, Applicant asserts that this feature in the rejected claim is not only novel, but also non-obvious. Therefore, the 102 rejection of claim 1 is overcome.

Claims 2-7, 11, and 12 stand rejected under 35 USC 103(a) as being unpatentable over Lipman ('363) as applied to claim 1. In light of the forgoing remarks regarding the 102 rejection of claim 1, the 103 rejection of claims 2-7, 11, and 12, which depend from amended claim 1 has been overcome in view of Lipman.

Claims 2-7, 11, and 12 stand further rejected under 103 as being unpatentable over Lipman in view of Annas. In particular, the office action states that Lipman ('392) shows the invention substantially as claimed except for the gripping means 61 attached to the leading edge 60 of the horizontal planar member 55. The office action further states that Annas ('392) shows that it is known in the art to provide a gripping means "182" as shown in Fig. 2 to at least the leading edge to fasten the housing to the windshield of the vehicle. This rejection is respectfully traversed.

To reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness. See In re Deuel, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed Cir. 1995). It is essential that the examiner avoid "the subtle but powerful attraction of a hindsight-based obvious analysis." In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) because the United States Court of Appeals for the Federal Circuit has made it abundantly clear that the examiners of the Patent and Trademark Office may not reject inventions by using the "tempting but forbidden zone of hindsight." In re Dembiczak, at 1616 (quoting Locitite Corp. v. Ultraseal Ltd., 781 F.2d 861, 228 USPQ 90, 98 (Fed. Cir. 1985)). See In re Dembiczak ("Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence".); McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, USPQ2d 1129, 1131 (Fed Cir. 1993)("Mere denials and conclusory statements, however, are not

sufficient to establish a genuine issue of material fact.”); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)(“The examiner’s conclusory statement ... is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection.”) The examiner may not use the “inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability.” In re Dembiczak, at 1617.

Although the suggestion to combine references may flow from the nature of the problem, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), the suggestion more often comes from the teachings of the pertinent references, see In re Sernaker, 702 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983), or from the ordinary knowledge of those skilled in the art that certain references are of special importance in a particular field, see Pro-Mold, 75 F.3d at 1573 (citing Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985)). Therefore, “[w]hen determining the patentability of a claimed invention which combines two known elements, ‘the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.’” See In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 448 (Fed. Cir. 1984)).

“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." See In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998).

The present office action states that although Lipman does not disclose a gripping means, Annas shows that it is known in the art to provide a gripping means to at least the leading edge to fasten the housing to the windshield of the vehicle. Assuming, arguendo, that it is known to provide a gripping means to fasten the housing to the windshield, the gripping means described in the present invention does not fasten the housing to the windshield, but merely abuts the windshield and acts as a bumper between the horizontal planar member and the windshield. The housing is instead mounted to the interior roof or headliner of the vehicle with a fastening means. As stated in the Detailed Description:

*Housing (5) of the present invention is mounted to the interior of a vehicle through use of fastening means (50) which fasten attachment means (45) to headliner (80). Housing (5) is preferably placed to maximize exterior illumination by light generators (20) so that front face (12) of vertical planar member (10) is vertically aligned with joint (85). Such placement of housing allows horizontal planar member (55) to extend to windshield (65) so that leading edge (60) abuts interior surface (70) at gripping means (61), thereby shielding the interior of the vehicle from refracted light emitted from light generators (20) during operation. Gripping means (61) acts to prevent movement between windshield (65) and horizontal planar member (55).*

(Page 7, lines 14-21, emphasis supplied). The gripping means is further referred to as "a rubber bumper or a plurality of rubber cylinders" on page 6, line 20, of the Detailed Disclosure. Through the use of material such as rubber, the gripping means can minimize movement between the windshield and the horizontal planar member.

There is no motivation in either Lipman or Annas to provide a housing that is mounted to the interior roof of a vehicle and that has a gripping means that acts as a

bumper between the horizontal planar member and the windshield. Both Lipman and Annas disclose a device that is mounted directly onto the windshield of the vehicle. As previously stated, claim 1 has now been amended to include the following: "means for internally mounting said housing to said interior roof of said vehicle." Although Annas discloses a gripping means "182" for mounting the device to the windshield, Annas does not also disclose a fastening means for mounting the device to the interior roof or headliner of the vehicle. Because each of the rejected claims depend from amended claim 1, this limitation is now included in these claims. Accordingly, the 103 rejection of claims 2-7, 11, and 12 has been overcome.

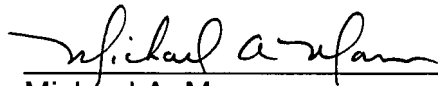
Claims 8-10 and 13-16 stand objected to as being dependent upon a rejected base claims. The office action further indicates that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 8-10 depend either directly or indirectly from claim 1. In light of the amendment to claim 1 and the forgoing remarks regarding the 102 and 103 rejections, Applicant believes that claim 1 is now allowable. Accordingly, claims 8-10 are also in allowable form and the objection of these claims is overcome.

Claims 13-16 are now canceled and new claims 17-20 have been added incorporating their limitations and the limitations of the base claim. Although these new claims include the limitations of claim 1, the limitations have been written as method claims. Accordingly, Applicant asserts that these claims are also in allowable form and the objection to the claims is overcome.

In view of the foregoing amendments and remarks, it is believed that the present application is in condition for allowance and reconsideration of it is requested. If examiner disagrees, he is urged to call the attorney for applicant at the number provided below.

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Michael A. Mann  
Attorney for Applicant  
Reg. No. 32825  
Nexsen Pruet Jacobs & Pollard LLC  
PO Drwr 2426  
Columbia, SC 29202-2426  
803-771-8900